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OFFICE OF PETITIONS

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In re Patent No. 7,018,837 : DECISION ON PATENT TERM
Issued: March 28, 2006 : ADJUSTMENT and NOTICE OF
Application No. 09/944,884 : INTENT TO ISSUE CERTIFICATE
Filed: August 31, 2001 : OF CORRECTION
Atty. Dkt. No.: 10466/134 :
P2548P1C15 : :

This is a decision on the "APPLICATION FOR PATENT TERM ADJUSTMENT PURSUANT TO 37 C.F.R. § 1.705(b)," filed May 30, 2006. This matter is being properly treated under 37 CFR 1.705(d) as a timely filed application for patent term adjustment.

The application for patent term adjustment ("PTA") under 37 CFR 1.705(d) is DISMISSED.

The above-identified application matured into U.S. Patent No. 7,018,837 on March 28, 2006. The instant request for reconsideration was timely filed May 30, 2006 (certificate of mailing date of May 24, 2006) in accordance with 37 CFR 1.705(d). The patent issued with a PTA of 534 days. Patentees argue that the patent is entitled to an adjustment of 811 days.

A review of the application history reveals that at the time of issuance, an overall adjustment of 701 days could be attributed to the Office.

As acknowledged by patentees, an adjustment of 284 days can be attributed to the Office in accordance with 37 CFR 1.702(a)(1) and 1.703(a)(1).

As further acknowledged by patentees, an adjustment of 417 days in accordance with 37 CFR 1.702(a)(4) and 1.703(a)(6) can be attributed to the Office.

As to patentees' contention that the patent is entitled to an additional adjustment of 277 days in accordance with 37 CFR 1.702(b), patentees are advised that if an application is entitled to an adjustment under 35 U.S.C. 154(b)(1)(B) (and 37

C.F.R. § 1.704(b)), the entire period during which the application was pending (except for periods excluded under 35 U.S.C. 154(b)(1)(B)(i)-(iii)), and not just the period beginning three years after the actual filing date of the application, is the period of delay under 35 U.S.C. 154(b)(1)(B) in determining whether periods of delay overlap under 35 U.S.C. 154(b)(2)(A). Thus, any days of delay for Office issuance of the application that overlap with the days of patent term adjustment accorded prior to the issuance of the patent will not result in any additional patent term adjustment. See, 35 U.S.C. 154(b)(1)(B), 35 U.S.C. 154(b)(2)(A), and 37 CFR § 1.703(f). See, also, *Revision of Patent Term Extension and Patent Term Adjustment Provisions; Final Rule*, 69 Red. Reg. 21704 (April 22, 2004).

Therefore, there were no adjustments accorded under 37 CFR 1.702(b) for failure to issue the patent within three years of the application filing date because the days of delay for failure to issue the patent more than three years after the filing date of the application overlap with the days of patent term adjustment accorded under 37 CFR 1.702(a).

The adjustment of 701 days is properly reduced a total of 193 days as further discussed herein.

As acknowledged by patentees, the adjustment of 701 days is properly reduced three days in accordance with 37 CFR 1.704(b).

The adjustment of 701 days is further reduced 70 days, and not 44 days as previously assessed, in accordance with 37 CFR 1.704(c)(8). The reduction began April 16, 2004, the day after the date that the initial reply to the final Office action was filed, and ended June 24, 2004, the date the supplemental reply to the final Office action was filed.

The adjustment is further reduced 120 days, the maximum period of reduction allowed, in accordance with 37 CFR 1.704(c)(10) in connection with the petition to correct inventorship filed September 13, 2004. Submission of the petition to correct inventorship after Notice of Allowance is deemed a failure to engage in reasonable efforts to conclude prosecution.

Patentees' contend that the miscellaneous paper submitted by applicants on October 4, 2004 did not constitute a failure to engage in reasonable efforts to conclude prosecution. Patentees' arguments have been considered and are found convincing. In this instance, this miscellaneous paper submitted October 4, 2004 is deemed a response to the examiner's reasons for allowance and

not a failure to engage in reasonable efforts to conclude prosecution within the meaning of 37 CFR 1.704(c)(10).

In view thereof, at the time of issuance, the patent is entitled to an adjustment of 508 days.

Any request for reconsideration of this decision must be submitted within two month of the mail date indicated above. Extensions of time under 37 CFR 1.136 are not permitted.

Receipt is hereby acknowledged of the required patent term adjustment application fee of \$200.00.

This application file will be forwarded to the Certificate of Corrections branch for issuance of a certificate of correction to indicate that the term of this patent is extended or adjusted under 35 U.S.C. 154(b) by 508 days.

Telephone inquiries specific to this matter should be directed to Petitions Attorney Alesia M. Brown at (571) 272-3205.

Kery Fries

Kery Fries
Senior Patent Attorney
Office of Patent Legal Administration
Office of Deputy Commissioner
for Patent Examination Policy

CC: Draft Certificate of Correction

may be a duplicate draft

Day : Tuesday
Date: 9/26/2006

Time: 13:25:02

PALM INTRANET

PTA Calculations for Application: 09/944884

Application Filing Date:	08/31/2001	PTO Delay (PTO):	701
Issue Date of Patent:	03/28/2006	Three Years:	0
Pre-Issue Petitions:	0	Applicant Delay (APPL):	167
Post-Issue Petitions:	0	Total PTA (days):	534
PTO Delay Adjustment:	0		

File Contents History

Number	Date	Contents Description	PTO	APPL	START
71.5	03/08/2006	PTA 36 MONTHS			
71	03/28/2006	PATENT ISSUE DATE USED IN PTA CALCULATION	417		67
70	02/16/2006	RECEIPT INTO PUBS			
69	02/15/2006	DISPATCH TO FDC			
68	02/15/2006	APPLICATION IS CONSIDERED READY FOR ISSUE			
67	10/04/2004	ISSUE FEE PAYMENT VERIFIED			
66	10/04/2004	MISCELLANEOUS INCOMING LETTER		120	62
65	02/08/2006	CORRESPONDENCE ADDRESS CHANGE			
64	02/08/2006	RECEIPT INTO PUBS			
63	01/20/2006	RECEIPT INTO PUBS			
62	01/13/2006	MAIL MISCELLANEOUS COMMUNICATION TO APPLICANT			
61	01/12/2006	MISCELLANEOUS COMMUNICATION TO APPLICANT - NO ACTION COUNT			
60	11/17/2005	PUBS CASE REMAND TO TC			
59	09/23/2005	TC RETURN TO PUBS			
58	09/12/2005	PUBS CASE REMAND TO TC			
57	05/17/2005	RECEIPT INTO PUBS			
56	05/06/2005	RECEIPT INTO PUBS			
55	09/13/2004	RULE 47 / 48 CORRECTION OF INVENTORSHIP PAPERS FILED			
54	04/26/2005	CORRESPONDENCE ADDRESS CHANGE			
53	04/26/2005	CHANGE IN POWER OF ATTORNEY (MAY INCLUDE ASSOCIATE POA)			
52	04/22/2005	RECEIPT INTO PUBS			
51	12/06/2004	WORKFLOW - QUERY REQUEST - FINISH			

50	11/08/2004	WORKFLOW - QUERY REQUEST - BEGIN			
49	10/15/2004	RECEIPT INTO PUBS			
48	09/30/2004	ISSUE FEE PAYMENT RECEIVED			
47	09/13/2004	WORKFLOW INCOMING PETITION IFW			
46	09/08/2004	WORKFLOW - QUERY REQUEST - BEGIN			
45	08/16/2004	RECEIPT INTO PUBS			
44	08/04/2004	SEQUENCE FORWARDED TO PUBS ON TAPE			
43	07/30/2004	WORKFLOW - FILE SENT TO CONTRACTOR			
42	07/14/2004	MAIL NOTICE OF ALLOWANCE			
41	07/13/2004	ISSUE REVISION COMPLETED			
40	07/13/2004	NOTICE OF ALLOWANCE DATA VERIFICATION COMPLETED			
39	07/10/2004	NOTICE OF ALLOWABILITY			
38	07/01/2004	DATE FORWARDED TO EXAMINER			
37	06/24/2004	AMENDMENT AFTER FINAL REJECTION		44	44
36	06/24/2004	REQUEST FOR EXTENSION OF TIME - GRANTED		70	31
35	05/06/2004	MAIL ADVISORY ACTION (PTOL - 303)			
34	05/05/2004	ADVISORY ACTION (PTOL-303)			
33	04/20/2004	DATE FORWARDED TO EXAMINER			
32	04/15/2004	AMENDMENT AFTER FINAL REJECTION			
31	04/15/2004	WORKFLOW INCOMING AMENDMENT IFW			
30	02/11/2004	MAIL FINAL REJECTION (PTOL - 326)			
29	02/03/2004	FINAL REJECTION			
28	12/03/2003	IFW AMENDED CASE PROCESSING COMPLETE			
27	11/14/2003	INFORMATION DISCLOSURE STATEMENT (IDS) FILED		0	24
26	11/14/2003	AFFIDAVIT(S) (RULE 131 OR 132) OR EXHIBIT(S) RECEIVED			
25	12/03/2003	DATE FORWARDED TO EXAMINER			
24	11/14/2003	RESPONSE AFTER NON-FINAL ACTION		3	23
23	08/11/2003	MAIL NON-FINAL REJECTION	284		-1
22	08/11/2003	NON-FINAL REJECTION			
21	09/03/2002	PRELIMINARY AMENDMENT			
20	07/29/2003	CORRESPONDENCE ADDRESS CHANGE			
19	07/29/2003	CORRESPONDENCE ADDRESS CHANGE			
18	07/29/2003	CORRESPONDENCE ADDRESS CHANGE			
16	05/15/2003	CASE DOCKETED TO EXAMINER IN GAU			

15	12/20/2002	CASE DOCKETED TO EXAMINER IN GAU
14	04/29/2002	INFORMATION DISCLOSURE STATEMENT (IDS) FILED
13	04/03/2002	CASE DOCKETED TO EXAMINER IN GAU
12	03/27/2002	X-PRE-LEGAL COMPLETE NEW CASE
11	03/27/2002	CASE DOCKETED TO EXAMINER IN GAU
10	03/27/2002	X-PRE-LEGAL COMPLETE AMENDED CASE
9	08/31/2001	PRELIMINARY AMENDMENT
8	08/31/2001	PRELIMINARY AMENDMENT
7	01/09/2002	CRF IS GOOD TECHNICALLY / ENTERED INTO DATABASE
6	01/09/2002	APPLICATION DISPATCHED FROM OIPE
5	01/08/2002	APPLICATION IS NOW COMPLETE
3	08/31/2001	CRF DISK HAS BEEN RECEIVED BY PREEXAM / GROUP / PCT
2	09/17/2001	IFW SCAN & PACR AUTO SECURITY REVIEW
1	08/31/2001	INITIAL EXAM TEAM NN

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EXPLANATION OF PTA CALCULATION

EXPLANATION OF PTE CALCULATION

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UNITED STATES PATENT AND TRADEMARK OFFICE
CERTIFICATE OF CORRECTION

PATENT : 7,018,837 B2
DATED : March 28, 2006
INVENTOR(S) : Filvaroff, et al.

It is certified that error appears in the above-identified patent and that said Letters Patent is hereby corrected as shown below:

On the cover page,

[*] Notice: Subject to any disclaimer, the term of this patent is extended or adjusted under 35 USC 154(b) by 534 days

Delete the phrase "by 534 days" and insert – by 508 days--